

III. Remarks

Claims 1 – 31 have been cancelled and claims 32 – 83 have been added. New independent apparatus claim 32 and independent method claim 65 are allowable for the following reasons.

New independent claim 32 recites an automatic separator/extractor comprising conveying means for moving along a closed path and for receiving at least one vessel; a dispenser for dispensing a reagent, or the like, into the vessel as it moves along the path; at least one of nozzle adapted for insertion into the vessel, means for effecting relative vertical movement between the nozzle and the vessel in order to insert the nozzle into the vessel; and a mechanism for inclining the nozzle and vessel with respect to a vertical axis to pass liquid, other than a precipitate, from the vessel and into the nozzle.

Although some of the previous claims were rejected under 35 U.S.C. §102(b) as being anticipated by Ammann et al., this patent is not applicable to new claim 32 for the following reasons:

The PTO provides in MPEP §2131 that

“...[t]o anticipate a claim, the reference must teach every element of the claim...”

Therefore, to support these rejections with respect to new claim 32, Ammann et al., must contain all of the above-claimed elements of the claim. However, this patent does not disclose the combination of conveying means for moving along a closed path and for receiving at least one vessel; a dispenser for dispensing a reagent, or the like, into the vessel as it moves along the path; at least one nozzle adapted for insertion into the vessel, means for effecting relative vertical movement between the nozzle and the vessel in order to insert the nozzle into the vessel; and a mechanism for inclining the nozzle and vessel with respect to a vertical axis to pass liquid, other than a precipitate, from the vessel and into the nozzle.

It is therefore very clear that the previous rejections based on 35 U.S.C. §102(b) cannot be supported by the Ammann et al. as applied to claim 32.

Some of the previous claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Ammann et al. in view of Vance, Sr. However, this rejection is not applicable to new claim 32 for the following reasons.

As the PTO recognizes in MPEP §2142:

"...examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.."

The examiner clearly cannot establish a *prima facie* case of obviousness in connection with new claim 32 for the following reasons.

35 U.S.C. §103(a) provides that:

"...a patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains... (emphasis added)"

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, Ammann et al., Butz and Melet alone, or in any combination, do not teach the combination of conveying means for moving along a closed path and for receiving at least one vessel; a dispenser for dispensing a reagent, or the like, into the vessel as it moves along the path; at least one nozzle adapted for insertion into the vessel, means for effecting relative vertical movement between the nozzle and the vessel in order to insert the nozzle into the vessel; and a mechanism for inclining the nozzle and vessel with respect to a vertical axis to pass liquid, other than a precipitate, from the vessel and into the nozzle.

Therefore, it is impossible to render the subject matter of claim 32 as a whole obvious based on any combination of the patents, and the above explicit terms of the statute cannot be met. As a result, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 32, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the Ammann et al., Butz and Melet patents, cannot be combined and applied to reject claim 32 under 35 U.S.C. §103.

The PTO also provides in MPEP §2142:

“...[T]he examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art..”

Here, the Ammann et al., Butz and Melet do not teach, or even suggest, the desirability of the combination since none of the patents teaches or suggests the combination of conveying means for moving along a closed path and for receiving at least one vessel; a dispenser for dispensing a reagent, or the like, into the vessel as it moves along the path; at least one nozzle adapted for insertion into the vessel, means for effecting relative vertical movement between the nozzle and the vessel in order to insert the nozzle into the vessel; and a mechanism for inclining the nozzle and vessel with respect to a vertical axis to pass liquid, other than a precipitate, from the vessel and into the nozzle.

Thus, none of these patents provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references in any combination to support a 35 U.S.C. §103(a) rejection of claim 32.

In this context, the PTO further provides in MPEP §2143.01:

“...The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination..” (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the examiner's combination arises solely from hindsight

based on the invention without any showing, suggestion, incentive or motivation in any of the references for the combination as applied to claim 32. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 32, and a rejection under 35 U.S.C. §103(a) is not applicable.

New independent claim 65 is a method version of claim 32 and is therefore allowable for the reasons set forth above. Dependent claims 33-64 and 66-83 further limit independent claims 32 and 65 in a patentable sense, and therefore are allowable as well.

In view of all of the above, a formal notice of the allowance of claims 32-83 is respectfully requested.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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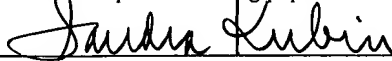
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